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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES

Re: Application of Roman Golicz et al.

Serial No. 08/962,077

Date: May 27, 2004

Filed: September 14, 1998

Examiner: D. Bollinger

Applicant: Roman Golicz et al.

Art Unit: 3651

Title: Sheet Feeding Apparatus

Atty. No. 9534

REPLY BRIEF

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Applicant responds to the examiner's answer as follows:

1. Since the final rejection is under 35 USC 102, based on either Habich or Anderson, each and every element of the invention has to be disclosed by either reference.

Examiner's answer says that the engagement of Anderson shaft 49 with body 52 imparts applicants' first moment. (Applicants agree that Anderson shows apparatus which has the second moment.)

The analysis for Habich is the same as Anderson. Thus, applicants reply with respect to Anderson. Their reply is in same tenor for Habich, but they avoid articulation to avoid repetition.

Applicants claim 26 is for both "a body...pivotably engaged with the shaft" and "means for imparting to the body a first moment created by rotary friction". The references used by examiner support as prior art only one of those elements, namely, that Anderson's shaft 49 engages with body 52, and is "pivotably mounted" (as Anderson states at Col. 3, line 13-14). And, as mentioned on page 3 of the appeal brief, Habich says "body 11 is free to rotate on shaft 1".

However, there is nothing in Anderson which suggests that there is present the second element, namely the first moment, which presses the second roller against an incoming article. Anderson's

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wording and teaching is simply "pivotably mounted". There is no implication of first moment. The rejection cannot be based on examiner's hindsight assumption, as it is, that there will be such a moment.

To the extent some very slight friction might be inherent in any pivotably engaged body (since nothing is totally frictional-less, including "anti-friction" (ball) bearings), applicants' claim would not read on such. This is so because of the structure of their claim, as above, where the "means for imparting...first moment" is an element beyond whatever results from merely being "pivotably engaged". For example, in claim 28 there is a stretchable belt to create the first moment. (This compares with familiar fabric-reinforced timing belts which are not stretchable.) For another example, as shown in applicants' Fig. 18, there is a friction creating clutch.

2. As to the Marzullo patent: Applicants claim apparatus where the second roller is higher in elevation than the first roller (not higher "than the plane" as the brief erroneously says at page 4 at (3)(ii)).

It appears examiner mistakenly calls roller 20 the second roller, which roller runs on shaft 22. The second roller, within the meaning of applicants' claim 30, is that which is at the free end of the body. Applicants' claimed first roller is that which runs on the shaft 28. In Marzullo, the corresponding second roller is roller 30, which is at the free end of pivotable arms 36. See his Fig. 1.

In Marzullo second roller 30 is lower than first roller 20, where elevation is measured relative to the plane of the article flow path, as claimed. In Marzullo Fig. 1, that plane is inclined downwardly to the right. Marzullo's lower elevation second roller 30 is consistent with the other prior art, as indicated in applicants' brief. Thus, the rejection of claim 30 and those dependent thereon is not supported by the references cited. The references teach away.

Even if Marzullo showed something meaningful about elevations, the answer does not address applicants' point that the combination of Anderson or Habich with Marzullo is an inoperable device which cannot teach the invention; nor does the examiner indicate any suggestion or motivation to combine.

3. As to the rejection based on O'Brien, it seems that the present examiner, having succeeded to the case, misapprehends what is meant by "bifurcated end", since he cites 62, 68 of O'Brien. It seems those would support a body having a cut-out of the bearing circle, i.e., the way in which any single link 40 engages a shaft. As stated unambiguously in specification page 7, second line from bottom, continuing onto the next page, it is the whole of end 27 of the body 26 which is bifurcated. Thus, the end is H-shape looking down, and has two legs which contact the shaft, straddling roller 22. That is the bifurcated body of claim 27. See also applicants' Fig. 2, and the first paragraph on page 7. O'Brien's two spaced apart links 40, one on either side of roller 39, can move independently. They do not teach a unitary body having two spaced apart legs. To combine the links for a teaching of such a bifurcated body is hindsight.


Applicants' intent in pointing out how the O'Brien apparatus functions, and has a different use, and how O'Brien belt rotates in a different direction, has two purposes: First, it shows the rejection is based on picking and choosing from the prior art; and on hindsight, where there is no suggestion or motivation to combine the references. Second, it shows the functional combination would be inoperable.

4. With respect to the configuration of the belt, claims 31-32, 45. The answer says "applicant has shown no clear teaching as to the criticality of aspect ratios". Applicants are surprised by this because they thought the law (35 USC 102) was that they were entitled to a patent unless their invention was known or obvious. They thought it is the examiner who is supposed to find the teaching of obviousness. Here, examiner asserts, based on one reference, and without other citation, that it is routine skill to vary in direction of what applicants' claim, and therefore there needs to be criticality. The Watanabe reference does not teach what applicants claim and it does not suggest any variation, or any range, in the direction of applicants' claimed belt. Thus, applicants contend they do not have to show criticality. They claim a belt which has novel function (claim 31) and novel dimensions (claims 32, 45). Nonetheless, please refer again to the bottom part of page 5 of the brief, where applicants have stated their case for the unique characteristics (criticality) of their claimed belt configuration, insofar as shedding debris, etc., compared to the prior art where belt ribs, as in Watanabe, are blunt.

5. Examiner repetitively says that applicants' arguments are without merit. It is not reasonable to say that, notwithstanding the examiner finds they have insufficient merit to

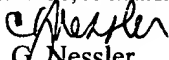
persuade him. Applicants submit the answer is wrong on this point, and that the claims ought to be allowed, as previously submitted in their appeal brief.

Respectfully submitted,
ROMAN M. GOLICZ ET AL.

By 
Their Attorney

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 27, 2004.


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